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UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of
SEO, et al.

Application No.: 10/031,857

PCT No.: PCT/KR00/01529

Int. Filing Date: 23 December 2000

Priority Date: 23 February 2000

Attorney Docket No.: 28875-102

For: APPARATUS AND METHOD FOR SEARCHING:
DIGITAL AUDIO DATA FILE FROM MEDIA
WHERE DIGITAL AUDIO DATA FILES ARE
RECORDED

DECISION ON REQUEST

UNDER 37 CFR 1.42

This is a decision on applicant's "Response to Notification of Missing Requirements Under 35 U.S.C. 371 in The United States Designated/Elected Office (DO/EO/US)" filed in United States Patent and Trademark Office (USPTO) on 09 July 2002. The response is being treated as a request for acknowledgment of status under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 23 December 2000, applicant filed the international application, which claimed a priority date of 23 February 2000. A Demand for international preliminary examination, in which the United States was elected, was not filed prior to the expiration of 19 months from the priority date. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 23 October 2001.

On 22 October 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee and an International Search Report. An executed oath or declaration of the inventors was not included.

On 03 April 2002, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date and providing a surcharge for providing the oath or declaration later than the appropriate 20 or 30

months from the earliest priority date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 09 July 2002, applicant filed the current papers which included a check for \$120.00 (\$65.00 surcharge for providing an oath or declaration later than thirty months from the priority date and \$55.00 as payment for a one-month extension of time); a petition for a one-month extension of time and a declaration/power of attorney executed by joint inventor Han-Kyo KIM, Seung-Jeong PARK and Suk-Jin HONG as well as Bum-Ho SEO and Bong Ja CHOI as heirs of the deceased joint inventor Youn-Deuk SEO.. With the filing of the petition for a one-month extension of time, payment of the fee and certification that the papers were deposited for mailing on 02 July 2002, the papers are considered timely filed.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

“In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.”

The declaration filed 09 July 2002 was executed by Bum-Ho SEO and Bong Ja CHOI as heirs of the deceased inventor, Youn-Deuk SEO. However, the declaration is not in compliance with 37 CFR 1.497 (a)-(b) as the declaration does not set forth the residence, post office address and country of citizenship of the deceased joint inventor Youn-Deuk SEO or the heirs as required under 37 CFR 1.497(b). While applicant has provided this information in a separate piece of correspondence, the information must be provided for both the deceased joint inventor, Youn-Deuk SEO and both surviving heirs on the declaration itself. In addition, 37 CFR 1.497(b)(2) states that in cases where the person making the oath or declaration is not the inventor, “[T]he oath or declaration shall state the relationship of the person to the inventor...” The present declaration does not contain such a statement. The heirs should identify themselves as the legal representatives of the deceased inventor in the oath or declaration; if there is no appointed executor or administrator. (See MPEP 409.01(a)).

CONCLUSION

Applicant's petition under 37 CFR 1.42 is **DISMISSED, without prejudice.**

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Application No.: 10/031,857

3

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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